

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U. S. Patent No. : 6,878,725 B2
Issue Date: : April 12, 2005
Application No. : 10/030,189
First Named Inventor : John Walter Liebeschuetz
Attorney Docket No. : X14660
Customer Number : 25885

RESPONSE TO DECISION ON APPLICATION FOR
PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

This submission is in response to the Decision on Application for Patent Term Adjustment in the above referenced patent with a mailing date of November 2, 2006, with a period for response of two months.

The Commissioner hereby is authorized to charge any fee which may be required by this Response, or credit any overpayment, to Deposit Account No. 05-0840.

Reconsideration is requested as to the period of adjustment based on the excess of 237 days beyond four months from payment of the issue fee until grant of the patent. The petition as to this period was timely filed by the agent handling the application on June 2, 2005.

At page 3 of the Decision for which reconsideration is requested, there is a citation to the Notice entitled "*Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed after a Notice of Allowance*, 1247 OG 11 (June 26, 2001)," with a

list of examples [emphasis added] of papers which are not considered a “failure to engage in reasonable efforts” to conclude processing or examination of an application and which would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

At page 4 of the Decision, it is stated: “Filing of any papers after allowance, other than those identified in the Notice, will be treated as a failure to engage in reasonable efforts to conclude prosecution.”

It is submitted that the statement and basis for decision is arbitrary and incorrect because the list provided in the Notice was “exemplary” and not intended to be an exhaustive list. Accordingly, it is requested that the request for adjustment be reconsidered for the reasons discussed below.

In the prosecution of the application, the agent handling the application repeatedly requested that the Examiner acknowledge priority and confirm that the certified copies of the priority documents all had been received from WIPO. See, in the image file wrapper:

(1) 04-17-2003 - Response to Election / Restriction Filed, at page 4.

(2) 10-01-2003/12-24-2003 [retransmittal by fax of 10-01-2003 fax submission] - Informal or Non-Responsive Amendment after Examiner Action/Response after Non-Final Action, at page 23.

Nevertheless, the Examiner never did acknowledge priority nor confirm that the certified copies of the priority documents all had been received from WIPO. Subsequently, the Notice of Allowance and a Notice of Allowability (Form PTO-37) were received, again without the requested acknowledgement. [The “Notice of Allowability (Form PTO-37)” is incorrectly indexed in the image file wrapper at 03-22-2004 at the lower of the two documents described as “Notice of Allowance and Fees Due (PTOL-85).”]

Therefore, following the instructions at the bottom of page 2 of the Notice of Allowability (Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”), the agent submitted with the issue fee payment a paper with the indicated title to again request acknowledgement of foreign priority and confirmation that the certified copies of the priority documents all had been received from WIPO. This paper is mischaracterized in the image file

wrapper at 06-15-2004 as "Amendment after Notice of Allowance (Rule 312)," but it is not a Rule 312 amendment.

Accordingly, it will be seen on reconsideration, that the paper submitted on 06-15-2004 as "Comments on Statement of Reasons for Allowance" is, indeed, a paper submitted in a reasonable effort to conclude processing or examination of an application; and that the period of adjustment should be granted. (Also, note that, in spite of all the efforts of the agent, the Patent was granted without the "Foreign Application Priority Data" being printed on the cover page, requiring further processing in the form of the Request for Certificate of Correction of 06-02-2005.)

The undersigned (whose title is supplied below) is empowered to sign this document on behalf of the assignee, ELI LILLY AND COMPANY, an Indiana Corporation.

Respectfully submitted,

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22 December 2006